

REMARKS

Claims 1-19 are pending in the present application. In the present Office Action, the Examiner rejected Claims 1-9, 10-14, 16, and 18-19 under 35 U.S.C. §102(b), and Claims 5-8, 10, 14-15 and 17 under 35 U.S.C. §103(a). Each rejection is discussed below.

I. Rejection of Claims 1-2, 4, 11, 13-14, 16, and 18-19 Under 35 U.S.C. §102(b)

Claims 1-2, 4, 6, 9, 11-14, 16, and 18-19 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,203,345 (hereinafter, “the Kennedy patent”). In particular, the Examiner alleges, “Kennedy discloses in Fig. 1 a remote telemetry/system method comprising an implantable temperature sensing device (transmitter) implanted in vagina of a (dairy) cow (col. 3, line 27) to determine an estrus temperature of the cow, a signal receiver / receiving antenna and a digital computer, inherently, acting as a processor and a digital access device, each temperature device comprises an identification signal to indicate the cow identity and its temperature (col. 3, lines 8-10).” Office Action, page 2. The Applicants respectfully disagree.

The Kennedy patent does not teach all of the elements provided in present Claims 1 and 12. A claim is not anticipated by a prior art reference when that reference fails to describe each and every element as set forth in the contested claim. *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed.Cir. 1987).

A. The Kennedy Patent Fails To Teach The “Digital Access Device” Element Required In Claim 1

A required element of Claim 1 is a “digital access device.” The Kennedy patent fails to teach or describe a digital access device. The Examiner alleges, “a signal receiver / receiving antenna and a digital computer, inherently, acting as a processor and a digital access device.” Office Action, page 2. The Examiner is respectfully directed to the Specification at page 10, lines 19-21, wherein digital access device is defined as a personal digital assistant [that] may or may not utilize wireless technology.” An example of “personal digital assistant” includes, but is not limited to, a Palm Pilot (see, e.g.,

Specification at page 17, line 20). While the Examiner asserts that “digital computer” inherently describes a “digital access device,” the Kennedy patent does not actually use the term “digital computer,” but rather the term “receiver/computer.” No other reference to computer is made within the Kennedy patent. As such, the Kennedy patent does not describe the digital access devices (e.g., personal digital assistants).

Additionally, the Kennedy patent does not **inherently** describe a digital access device as required in Claim 1. Instead of citing a teaching in the Kennedy patent that requires a digital access device (e.g., personal digital assistant), the Examiner **speculates** that the invention described in the Kennedy patent utilizes digital access devices. This speculation cannot substitute for an actual or inherent teaching of the claimed element. Indeed, the Examiner is evidently applying a flawed inherency analysis. As the Federal Circuit has held in *Continental Can*:

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

Continental Can Company USA, Inc., v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991) (emphasis added) (holding no anticipation due to inherency). Thus, argued gaps in a reference must be filled by evidence that clearly shows the descriptive matter is necessarily present in order to shift the burden to the Applicant. This is a far more stringent standard than the standard urged by the Examiner. Indeed, inherency “may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* at 1269 (quoting *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981)). The burden does not shift to Applicant to prove the contrary until the Office presents an evidentiary basis for believing that the element is necessarily present in the cited reference.

In the present case, the Examiner is relying on possibilities. The “digital access device” claim element is not **necessarily** present in the cited references. The Kennedy patent does not teach, describe or suggest embodiments that **necessarily must** have a digital access device. For example, the receipt of radio signals described in the Kennedy patent may be accomplished through any number of devices (e.g., personal computers, lap-top computers, cellular telephones, etc.), not **necessarily** a digital access device (e.g.,

personal digital assistant). Indeed, the Kennedy patent fails to even mention digital access devices. Accordingly, the Kennedy patent does not teach, describe or suggest embodiments that **necessarily must** have a digital access device, and therefore does not anticipate Claim 1 of the present invention. Thus, the Applicant respectfully requests these rejections be withdrawn.

B. The Kennedy Patent Fails To Teach The “Transmittal Of An Estrus Message From Said Processor To Said Animal Identification Device” Element Required In Claim 12

Claim 12 provides a method requiring the transmittal of an estrus message from the processor to the animal identification device. The Kennedy patent fails to teach or describe such an estrus message from a processor back to the animal identification device. The Examiner asserts that the Kennedy patent inherently notifies the operator upon temperature monitoring. Office Action, page 3. Claim 12, however, does not require that the message be relayed to an operator, but rather, to the animal identification device. As the Kennedy patent fails to teach or describe the transmittal of an estrus message from a processor to an animal identification device, it also fails to anticipate Claim 12 of the present invention. The Applicants respectfully request these rejections be withdrawn.

II. Rejection of Claims 1-3 Under 35 U.S.C. §102(b)

Claims 1-3 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,865,044 (hereinafter, “the Wallace patent”). In particular, the Examiner alleges, “Wallace discloses a system comprising an implantable in a cow ear temperature sensing device (transmitter) comprising an identification number generated / processed by an encoder (processor) to be transmitted along with a temperature sensed, a signal receiver comprises a decoder (device receiving a bit rate / digital access device from the transmitter, and an animal identification device (display) (col. 2, lines 35-46). Office Action, page 3. The Applicants respectfully disagree.

The Wallace patent fails to teach each and every element of Claim 1 of the present invention. In particular, the Wallace patent does not teach or describe a digital access device. As noted above, the Examiner is respectfully directed to the Specification

at page 10, lines 19-21, wherein digital access device is defined as a personal digital assistant [that] may or may not utilize wireless technology.” An example of “personal digital assistant” includes, but is not limited to, a Palm Pilot (see, e.g., Specification at page 17, line 20). The Wallace patent fails to teach or describe a digital access device (e.g., personal digital assistant), and as such, fails to anticipate Claims 1-3 of the present invention. The Applicants respectfully request these rejections be withdrawn.

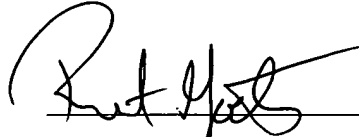
III. Rejections Under 35 U.S.C. §103(a)

The Examiner rejects dependent Claims 5-8, 10, 14-15, and 17 under 35 U.S.C. §103(a). Claims 5-8, 10, 14-15, and 17 are dependent upon non-obvious and non-anticipated Claims 1 and 12. As discussed in Sections I and II of this Office Action Response, the Kennedy and Wallace patents fail to teach all of the required elements within Claims 1 and 12. The other cited references do not remedy this deficiency. As such, a *prima facie* case of obviousness has not been established. The Applicants request these rejections be withdrawn.

CONCLUSION

All grounds of rejection of the Office Action of March 8, 2004 have been addressed and reconsideration of the application is respectfully requested. It is respectfully submitted that Applicant's claims should be passed into allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application Applicant encourages the Examiner to call the undersigned collect at (608) 218-6900.

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